

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: Howard Lincecum

EXAMINER: Aughenbaugh, W.

SERIAL NO.: 09/775,451

ART UNIT: 1772

FILING DATE: February 1, 2001

DOCKET NO: 94478-00

TITLE: Three-Layer Furniture Bag

Mail Stop APPEAL BRIEF-PATENTS

Commissioner of Patents

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Alexandria, VA 22313-1450

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**APPELLANT'S APPEAL BRIEF**

This brief is in furtherance of the Notice of Appeal filed on 16th day of July, 2003. Accordingly, Applicant is submitting herewith the instant Appeal Brief, in triplicate, and the required fee. The final page of this brief bears the attorney's signature.

**I. REAL PARTY IN INTEREST**

The real party in interest is Howard Lincecum.

**II. RELATED APPEALS AND INTERFERENCES**

(37 C.F.R. §1.192(c)(2))

There are no related appeals or interferences.

**III. STATUS OF THE CLAIMS**

(37 C.F.R. §1.192(c)(3))

Claims 1-4, 6-8, 11, 18 and 19 have been rejected by the examiner in the Final Office Action dated January 31, 2003. Claims 9 and 10 have been cancelled by Applicant in an Amendment filed by Applicant on September 11, 2003 in response to examiner's Final Office Action (Paper #10).

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#### **IV. STATUS OF AMENDMENTS** (37 C.F.R. §1.192(c)(4))

An amendment was filed on September 11, 2003 In response to examiner's March 31, 2003 Final Office Action. In the amendment, Applicant requested claims 9 and 10 be cancelled and the Abstract be amended. As a result of Applicant's cancellation of those claims and amendment to the specification, examiners objections and rejections stated as Items #4, #14, #17, and #18 of the Final Office Action are rendered moot. As such, arguments made by examiner in support of those rejections need not be, and therefore are not addressed by Applicant.

#### **SUMMARY OF THE INVENTION** (37 C.F.R. §1.192(c)(5))

##### **Claim 1.**

Claim 1 is directed to a bag formed of a dual surface material wherein the inside surface of the bag has a coefficient of friction in the range of approximately 0.125 to 0.275, and the outside surface of the bag has a coefficient of friction in the range of approximately 0.300 to 0.600.

##### **Claim 2.**

Claim 2 is directed to a dual surface bag as claimed in claim 1, wherein the dual surface material is a plastic.

##### **Claim 3.**

Claim 3 is directed to a dual surface bag as claimed in claim 1, wherein the dual surface material is a polymer.

##### **Claim 4.**

Claim 4 is directed to a dual surface bag as claimed in claim 2, wherein the plastic material is a polymer.

**Claim 6.**

Claim 6 is directed to a bag formed of a dual surface material wherein the inside surface of the bag has a coefficient of friction in the range of approximately 0.175 to 0.250 and the outside surface has a coefficient of friction range of approximately 0.350 to .600.

**Claim 7.**

Claim 7 is directed to a dual surface bag having three layers.

**Claim 8.**

Claim 8 is directed to a dual surface bag having 3 layers wherein the first layer has a coefficient of friction range of approximately 0.175 to 0.250, the second layer has a Dart Impact strength of approximately 95 grams per mil, and the third layer has a coefficient of friction range of approximately 0.350 to 0.600.

**Claim 11.**

Claim 11 is directed to the use of the dual surface bag of claim 1 as a protective covering in combination with an article of furniture. The dual surface bag in claim 11 has a polymer inside layer having a coefficient of friction range of approximately 0.125-0.275. The outside layer of the dual surface bag has a polymer surface with a coefficient of friction range of approximately 0.300 to 0.600.

**Claim 18.**

Claim 18 is directed to a bag formed of a dual surface material having an outer polymer film layer with a coefficient of friction range of approximately 0.300 to 0.600, and an inner polymer film layer having a coefficient of friction range less than the outer layer.

**Claim 19.**

Claim 19 is directed a the bag claimed in claim 18, further including a middle polymer film layer which has a dart impact strength of between approximately 70 and 200 grams per mil.

**ISSUES**

(37 C.F.R. §1.1912(c)(6))

The issues presented on appeal are:

Whether claims 1-4, 6-8, 11, 18, and 19 are unpatentable under 35 USC §103(a), as being obvious over Sugimoto et al.

**GROUPING OF CLAIMS**

(37 C.F.R. §1.1912(c)(7))

It is the Applicant's intention that rejected claims 1-4, 6-8, 18 and 19 stand or fall together, and claim 11 stands and falls on its own.

**ARGUMENT**

(37 C.F.R. §1.1912(c)(8))

**THE CITED PRIOR ART****I. Rejections under 35 USC §103(a)**

The examiner has rejected claims 1-4, 6-8, 11, 18 and 19 under 35 USC §103(a) as being unpatentable over Sugimoto et al.

**The Teachings of Sugimoto**

Sugimoto is directed to a multi-layer film and to a method of packaging an article using the multilayer film. The multilayer film when used to package an article comprises (1) an inner, low-density polyethylene-base resin layer, (2) an intermediate, polyolefin-based resin expanded layer and (3) an outer, high density polyethylene-based resin layer, in which the outer and inner surfaces are different in physical properties such as coefficient of friction, and which includes an intermediate expanded layer.

Inner Layer: The low density polyethylene-base resin will have a density of 0.900 to 0.940 g/cm<sup>3</sup>, preferably 0.905 to 0.935 g/cm<sup>3</sup> and particularly preferably 0.9110 to 0.930 g/cm<sup>3</sup>, and a melt index of 0.1 to 50 g/10 min, preferably 0.2 to 30 g/10 min, particularly preferably 0.3 to 20 g/10 min. The coefficient of static friction of the low density polyethylene-based resin layer surface is usually not less than 0.4, preferably not less than 0.5, and more preferably not less than 0.6. The low density polyethylene-based resin layer imparts anti-slipperiness and flexibility to the inner layer of the multi-layer film.

Intermediate Layer: The intermediate layer of the multi-layer film is a polyolefin-based resin expanded layer. Of the polymers that may be used as the polyolefin-based resin expanded layer, low density and linear low density polyethylene-based resin layers are preferred. For the low density polyethylene and linear low density polyethylene, the density is 0.900 to 0.940 g/cm<sup>3</sup> and preferably 0.910 to 0.930 g/cm<sup>3</sup>, and a melt index is 0.1 to 50 g/10 min and preferably 0.2 to 20 g/10 min.

Outer Layer: The third layer is the high density polyethylene-based resin layer. This layer has a density of 0.945 to 0.975 g/cm<sup>3</sup>, preferably 0.947 to 0.970 g/cm<sup>3</sup> and a melting index of 0.01 to 5 g/10 min, preferably 0.02 to 2 g/10 min. The coefficient of static friction of the high density polyethylene-based resin is usually not more than 0.35 and preferably not more than 0.3. The outer high density polyethylene-based resin layer imparts slipperiness, strength and stiffness to the multilayer film.

The thickness of the multi-layer film is usually 30 to 300 $\mu$  and particularly preferably 40 to 200 $\mu$  (col. 5, lines 14-15).

As defined in the claims 1 and 9 of Sugimoto et al., the multi-layer film is used in packaging an article in such a manner that the ethylene-vinyl acetate copolymer-based resin layer (layer with the highest coefficient of friction of the three layers) is in contact with the article. This requires the high density polyethylene-based resin layer (layer with the lowest coefficient of friction of the three layers) to be in contact with the buffering material. Therefore, the slickest surface faces away from the article being enclosed by the multi-layer film, and the roughest surface faces towards the enclosed article. Thus, when the packaged article is vibrated, the vibration is absorbed by the sliding between the film outer surface and the buffering material (col. 4, lines 56-61).

**1. Rejection of Claims 1-4, 6-8, 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al.**

In there simplest form, the facts surrounding the above referenced rejection are as follows:

- 1) Sugimoto teaches a multilayer film and package for packaging articles having a low density inner surface with a *higher* coefficient of friction relative to the film's high density outer surface;
- 2) Applicant's invention comprises a dual surface bag for packaging furniture wherein the high density inner surface has a *lower* coefficient of friction relative to the outer surface; and

3) In Sugimoto, the low density inner surface of the multilayered film, having a high coefficient of friction, contacts and adheres to the packaged article to prevent rubbing and movement of the article with the inner surface of the multilayer package film.

4) In Applicant's dual surface bag, the inner surface which comes in contact with the packaged article has a high density and low coefficient of friction to permit the easy sliding of the furniture into and out of a bag.

The facts are presented in the above manner to emphasize the point that the inner and outer layers of Applicant's dual surface bag are a complete reversal from the layers taught by the packaging in Sugimoto, and thus give Applicant's invention a completely distinct structural configuration. This reversal of the layers is what forms the basis of the examiner's rejection of claims 1-4, 6-8, 11, 18 and 19 under 35 U.S.C. 103(a). Examiner's basis for rejecting the above referenced claims is quite simply "...it would have been obvious to one having ordinary skill in the art at the time the invention was made to have switched the outer and inner layers in the film for packaging of Sugimoto et al., depending on the end-use of the product, in order to produce a bag with an outer layer with a higher coefficient of friction and a lower density than the inner layer so that an article can easily be removed from or placed in the bag..." Paper #6, page 7, paragraph 11.

Many times ordering information, steps or processes is simply to permit the human mind to more easily conceptualize the information. In such a case, the order is often irrelevant, and one step or number may be substituted for the next. It may appear intuitive to the examiner to think of two inventions having oppositely ordered layers of film densities and coefficients of

friction as obvious variations of one another. And this could be the case if reversing the layers of the multilayered film produced little or no difference in the functioning of the packaging. However, to do so in the present case neglectfully ignores the purpose and function behind the design of both the Sugimoto and Applicant's invention. As admitted by the examiner, Sugimoto "failed to teach the outer layer has a higher coefficient of friction and lower density than the inner layer, i.e., the inner layer and outer layers of Sugimoto are arranged opposite to the arrangement of the instant application" Paper #6, page 6, paragraph 11. As will be discussed in detail below, the structural design of the layers in Applicant's invention is critical to the intended functioning of Applicant's dual surface bag, and produces a far different result than the result produced by the packaging in Sugimoto.

Applicant's basis of appeal relies on the fact that the examiner has at no time formulated a valid *prima facie* obviousness case for the rejection of Applicant's claims under 35 U.S.C. 103(a). As stated in MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. Applicant strongly urges the Appeal Board to fully consider the following arguments in support of reversing the examiner's rejection: a) no motivation or suggestion is present to modify the invention in Sugimoto because reversing the order of the layers in Sugimoto would render that invention unsatisfactory for its intended purpose pursuant to MPEP 2143.01, b) the examiner's interpretation and reliance on *Ex parte Masham* in rejecting the above referenced claims in the Final Office Action is misapplied under the facts of the present case, c) the examiner's reliance on *In re Japikse* in rejecting Applicant's claims is improper under the facts of the instant case, d)



the examiner's proposed modification to Sugimoto would change the principle of the operation of that invention, and thus defeat *prima facie* obviousness under MPEP 2143.01, and e) the packaging disclosed in Sugimoto actually teaches away from Applicant's claimed invention.

a) the examiner's proposed modification to the multilayer packaging in Sugimoto would render that invention unsatisfactory for its intended purpose:

Section 2143.01 of the MPEP, citing *In re Gordon*, clearly states if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). " In *Gordon*, the claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located in the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference in *Gordon* taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a stopcock was located at the bottom of the device for periodically removing the collected dirt and water. That reference further taught that the separation is assisted by gravity. The Patent Appeal Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court in *Gordon* **reversed**, finding that if the prior art device was turned upside down **it would be inoperable for its intended purpose** because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of purified gasoline, and the screen would become clogged.

As stated in MPEP 2144.04, "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the

court." The facts in the present situation are certainly similar to the facts in *Gordon*, and therefore the rationale of *Gordon* should be applied to Applicant's case. Similar to the facts in *Gordon*, the inner and outer layers of Applicant's claimed dual surface bag are oriented in an opposite fashion to that of the layers in the Sugimoto multilayer packaging. Further comparable to *Gordon* is the fact that modifying the Sugimoto invention to have the same structural limitations of Applicant's invention would render Sugimoto unsatisfactory for its intended purpose. Sugimoto was attempting to solve the problem of damage to the surface of an article being packaged as a result of rubbing of the article by the polyethylene film surrounding that article (see column 1, lines 39-44 of Sugimoto et al.). Sugimoto's solution was to increase the coefficient of friction of the inner layer of the multilayered film such that the film would adhere to the article and not cause rub damage (see column 2, lines 34-39 of Sugimoto et al.). By modifying the layers of the packaging film disclosed by Sugimoto to include an inner layer having the same low coefficient of friction as does Applicant's inner layer, the rubbing problem that Sugimoto was trying to solve would only be aggravated. As opposed to adhering to the surface of the article, the modified inner surface of Sugimoto would undesirably promote slippage between the two surfaces. In addition, the multilayer packaging of Sugimoto includes an outer layer with a low coefficient of friction to promote easy slippage of a buffer material over the outer layer of the film. If the outer layer of the Sugimoto invention was modified to include the same high coefficient of friction as claimed in Applicant's outer layer, the buffer material would no longer easily slide over the article packaged in the Sugimoto film. Because modifying the layers of Sugimoto to have consistent coefficients of friction with Applicant's dual surface bag would defeat the intended functionality of the Sugimoto film, the examiner's

rejection of claims 1-4, and 6-8 should be withdrawn pursuant to the rationale of MPEP 2143.01 and *In re Gordon*.

The examiner argues MPEP 2143.01 and the holding of *Gordon* are inapplicable to the present case because the devices cited in *Gordon* are used for different purposes. Examiner argues in the Final Office Action (Paper 10, pages 6-7, paragraph 20):

*Paraphrased.* Whereas MPEP 2143.01 applies to devices that are used for entirely different purposes, Sugimoto et al. and Applicant's purpose is to enable slippage between the bag and an article. In the case of Sugimoto et al., the coefficient of friction of the outer layer of the bag is low to enable the bag to slip easily from the buffering material. In the case of Applicant, the coefficient of friction of the inner layer of the bag is low to enable the material to slip easily over the contents of the bag, as the specification of Applicant clearly establishes that it is important for the plastic layer of a bag that is in contact with furniture to have a low coefficient of friction so that "the reduced coefficient of friction of the bag material allows the bag to slip onto the furniture more easily". Therefore, Sugimoto and Applicant are dealing with the same problem, i.e., the selection of a polymeric composition to be formed into a film that is in contact with an article to achieve a desired degree of slippage between the film and the article as quantified by the coefficient of friction of the film. Therefore, one of ordinary skill in the art is indeed motivated to swap inner and outer layers in the film of Sugimoto et al. (which would entail merely flipping the bag of Sugimoto inside-out) at least for the goal of achieving a low degree of slippage on the inside of the bag so that an article may easily slip along the inside of the bag as opposed to along the outside of the bag as taught by Sugimoto et al.

Applicant has read the opinion in *Gordon* and finds the examiner's distinction that the devices in *Gordon* are used for different purposes lacks merit. Contrary to examiner's statement, the *Gordon* court does not assign any weight to the fact that one filter is used to filter blood and the other for gasoline.

The court in *Gordon* states "the question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but,

rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down." *Gordon* 3. As stated above, the *Gordon* court concluded the blood filter would not have been an obvious invention in view of the gasoline filter, because turning the gasoline filter upside down **would have rendered it inoperable for its intended function**. In the case of Applicant, the examiner argues in the Final Office Action that "one of ordinary skill in the art is indeed motivated to swap inner and outer layers in the film of Sugimoto et al. (which would entail merely flipping the bag of Sugimoto et al. inside-out) at least for the goal of achieving a low degree of slippage on the inside of the bag so that an article may easily slip along the inside of the bag as opposed to along the outside of the bag as taught by Sugimoto et al." Paper 10, page 7, paragraph 20. However, as stated by the court in *Gordon*, **"the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."** *Gordon* 3. Applicant fears the examiner is acting on *hindsight* alone in suggesting the packaging of Sugimoto be "flipped inside-out", because nothing in Sugimoto suggests the desirability to do so. The examiner applies extremely broad reasoning in suggesting that simply because Applicant's dual surface bag and the multilayered packaging of Sugimoto both disclose "slippage" between a low coefficient of friction layer and an article located adjacent to the low coefficient of friction layer, the two inventions are obvious variations of one another.. This argument is unpersuasive. Generally speaking, both inventions do disclose slippage, however there is absolutely no disclosure in Sugimoto which would suggest reversing the layers of the invention taught therein. Applicant therefore urges the Board to not use hindsight in evaluating this case. Although reversing the layers of the Sugimoto packaging, in hindsight, seems very simple, it must be remembered that: 1) there is no suggestion in Sugimoto to reverse the layers of

the multilayered packaging, 2) reversing the layers would, in fact, destroy the intended function of Sugimoto, and 3) reversing the layers of the Sugimoto invention would result in an unanticipated device with an entirely new function.

b) Examiner's interpretation and reliance on *Ex parte Masham* is misapplied under the facts of the present case.

To further buttress his contention that MPEP 2143.01 was not applicable to Applicant's case, the examiner argued in the Final Office Action (Paper #10, page 8, paragraph 20) that,

*Emphasis added by Applicant.* "the goals of Sugimoto et al. that Applicant points to as to why there is no motivation to make modifications to arrive at the bag of Applicant, i.e., avoiding rub damage and avoiding difficulty of slippage of the buffering material, are merely intended uses which do not constitute a patentable distinction, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article **satisfying the claimed structural limitations**. *Ex parte Masham*, 2 USPQd 1647 (1987)."

Having reviewed the facts of *Masham*, Applicant submits to the Appeal Board that the examiner improperly interpreted and relied upon *Masham* in support of rejecting Applicant's claims. In *Masham*, a claimed apparatus for mixing flowing developer was rejected under 35 U.S.C. 102 as being anticipated by a prior art apparatus **containing the same structural limitations** as the claimed invention. In that case, the applicant tried to appeal the examiner's rejection and distinguish his invention from the prior art by arguing applicant's invention claimed the additional intended use language, "completely submerged in the developer material". Because the claimed invention and the prior art **contained identical structural limitations**, the applicant's recitation in the claims of the manner in which the claimed invention was to be deployed was not considerable in overcoming the 35 U.S.C. 102 rejection.

The facts in *Masham* are distinguishable from the present situation. In contrast to *Masham*, Applicant's dual surface bag does not possess the same structural limitations as disclosed by the Sugimoto packaging. Further, the examiner's rejection of Applicant's claims in the present situation is under 35 U.S.C. 103(a) rather than the 35 U.S.C. 102 rejection in *Masham*. The obviousness rejection versus the lack of novelty rejection is significant because in the present case, Applicant is not trying to establish the novelty of its claimed invention by distinguishing disclosed functional differences of Applicant's invention from the Sugimoto. Rather, novelty has already been established and recognized by the examiner. The purpose of discussing the intended functionality of Sugimoto is merely to illustrate the point that modification of the layers of the Sugimoto packaging destroys the intended purpose of that invention, and thus defeats the examiner's claim of *prima facie* obviousness pursuant to the rationale of MPEP 2143.01. As a result, examiner's reliance on *Masham* in the present case is inappropriate.

c) The examiner's reliance of *In re Japikse* in support of rejecting Applicant's claims is improper.

The examiner also argued in the final office action that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have switched the outer and inner layers in the film for packaging of Sugimoto et al., depending on the end-use of the product, in order to produce a bag with an outer layer with a higher coefficient of friction and a lower density than the inner layer so that an article can easily be removed from or placed in the bag, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70." Once again, the examiner's reliance on case law is misapplied to the facts of Applicant's case. In *Japikse*, claims to a hydraulic power press which read on the

prior art except with regard to the position of the starting switch were held by the Board to be unpatentable because shifting the position of the starting switch **would not have modified the operation of the invention**. In contrast to the facts in *Japikse*, swapping the inner and outer layers of the Sugimoto packaging leads to a **completely new operation of the invention**. As discussed above, swapping the inner and outer layers destroys the adhering function of the inner layer of Sugimoto and defeats the slippage ability of the outer layer. As quoted from the MPEP 2144.04,

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is **not by itself sufficient to support a finding of obviousness**. The prior art must provide motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd.Pat.App. & Inter. 1984)"

Because modifying the structural design of Sugimoto to be consistent with Applicant's design would significantly alter the intended operation and function of the Sugimoto packaging, examiner's rejections of the abovementioned claims should be reversed.

d) the examiner's proposed modification to Sugimoto would change the principle of the operation of that invention, and thus defeat *prima facie* obviousness pursuant to MPEP 2143.01:

As mentioned above, no motivation is present in the Sugimoto disclosure to prompt one of ordinary skill in the art to modify the structural limitations of the Sugimoto packaging in order to create a *prima facie* case of obviousness against Applicant's invention. MPEP 2143.01 states that "if the proposed modification or combination of prior art would **change the principle of operation of the prior art invention** being modified, then the teachings of the references are not sufficient to render claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." As stated in *Ratti*, "the suggested combination of references would require a substantial

reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352. As stated previously, modifying Sugimoto to include the same structural limitations as Applicant's invention would violate Sugimoto's disclosed principle of operation. For example, Sugimoto was attempting to solve the problem of damage to the surface of an article being packaged as a result of rubbing of the article by the polyethylene film surrounding that article (see column 1, lines 39-44 of Sugimoto et al.). Sugimoto's solution was to increase the coefficient of friction of the inner layer of the multilayered film such that the film would adhere to the article and not cause rub damage (see column 2, lines 34-39 of Sugimoto et al.). By modifying the layers of the packaging film disclosed by Sugimoto to include an inner layer having the same low coefficient of friction as does Applicant's inner layer, the rubbing problem that Sugimoto was trying to solve would only be aggravated. As opposed to adhering to the surface of the article, the modified inner surface of Sugimoto would undesirably promote slippage between the two surfaces. In addition, the multilayer packaging of Sugimoto includes an outer layer with a low coefficient of friction to promote easy slippage of a buffer material over the outer layer of the film. If the outer layer of the Sugimoto invention was modified to include the same high coefficient of friction as claimed in Applicant's outer layer, the buffer material would no longer easily slide over the article packaged in the Sugimoto film. For the reasons stated herein, it should be evident to the Board that modifying the packaging in Sugimoto to be consistent with structural design of Applicant's claimed invention would completely destroy the intended operating principle of Sugimoto. As such, the examiner lacks the requisite support needed to establish *prima facie* obvious against Applicant's invention.



e) the packaging disclosed in Sugimoto actually teaches away from examiner's proposed modification of Sugimoto:

The teachings of Sugimoto may be interpreted as "teaching away" from any of the modifications of Sugimoto proposed by the examiner in support of forming an obviousness rejection of Applicant's claims. In the above cited *In re Gordon*, the court held that the prior art gasoline filter actually taught away from the structural design of the blood filter. Recall in that case the blood filter was oriented in an opposite fashion from the gasoline filter. Like in *Gordon*, the cited prior art, Sugimoto, actually teaches away from Applicant's claimed dual surface bag. The very function of Applicant's dual surface bag accomplishes exactly what Sugimoto was attempting to avoid. Applicant's outer surface has a high coefficient of friction to promote better gripping and handling of the packaged furniture and to provide a surface suitable for adhering labels thereto. In contrast, the Sugimoto packaging has an outer surface with a low coefficient of friction so that a packaged article can easily slide into and out of a buffer material such as Styrofoam or cardboard. Applicant's inner surface of the claimed dual surface bag is comprised of a high density, low coefficient of friction layer to permit furniture to slide easily into and out of the bag. In contrast, Sugimoto teaches an inner surface with a high coefficient of friction to prevent the movement of a packaged article enclosed within the film.

**2. Rejection of Claim 11 under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al.**

In the First Office Action (Paper #6) and Final Office Action (Paper #10), the examiner's rejection of claim 11 was supported by the same reasons used to support rejections of claims 1-4, 6-8, 18 and 19. As such, applicant's abovementioned arguments in 1(a)-(e) are herein reiterated. However, Applicant has elected to have claim 11 stand or fall on its own due to the independent

nature of claim 11 and the fact that "an article of furniture" is included as an element to the claim. While the arguments supporting 1-4, 6-8, 18 and 19 are substantially the same for claim 11, Applicant believes claim 11 may more clearly claim the distinction between the present invention and the prior art. By reciting an article of furniture with the dual surface bag of the present invention covering the furniture, claim 11 more clearly defines that the low coefficient of friction layer is the layer in contact with the furniture. Thus, claim 11 describes a system that is even more clearly the opposite of Sugimoto's concept of a high coefficient of friction layer resting against and clinging to the article inside the bag.

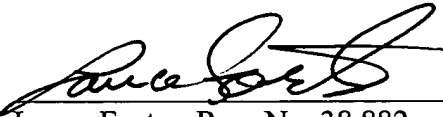
### CONCLUSION

Applicant has shown that the Examiner failed to meet his burden of presenting a *prima facie* case of obviousness under 35 U.S.C. §103. In support of Applicant's position, Applicant respectfully requests the Board to strongly consider the following reasons for overruling examiner's 35 U.S.C. 103(a) rejections of claim 1-4, 6-8, 11, 18 and 19: (a) examiner's proposed modification to the multilayer packaging in Sugimoto would render that invention unsatisfactory for its intended purpose, (b) examiner's interpretation and reliance on *Ex parte Masham* is misapplied under the facts of Applicant's case, (c) the examiner's reliance of *In re Japikse* in support of rejecting Applicant's claims is improper, (d) the examiner's proposed modification to Sugimoto would change the principle of the operation of that invention, and thus defeat *prima facie* obviousness pursuant to MPEP 2143.01, (e) and the packaging disclosed in Sugimoto actually teaches away from examiner's proposed modification of Sugimoto. In light of there being no suggestion to modify the packaging in Sugimoto to have similar structural limitations as Applicant's invention, the examiner's rejections are likely impermissibly based upon hindsight. Considering the Response to Final Office Action filed on September 11, 2003, Applicant

believes the application is now in condition for allowance. Therefore, Applicant requests that the Board of Patent Appeals and Interferences give consideration to the arguments presented herein and further requests the prosecution of this case be remanded to the primary examiner with a recommendation that the application be allowed.

Respectfully Submitted,

DATE: 16 SEPT 03

  
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## APPENDIX OF CLAIMS ON APPEAL

The following claims, and the respective status of each claim, are accurate and represent Applicant's most recent versions of the same. These claims are the same claims submitted to examiner in Applicant's September 11, 2003 response to examiner's Final Office Action.

1(previously amended). A bag formed of a dual surface material wherein said dual surface material comprises:

- a. an inside surface having a coefficient of friction range of approximately 0.125 to 0.275; and
- b. an outside surface having a coefficient of friction range of approximately 0.300 to 0.600.

2(original). The dual surface bag of claim 1, wherein said dual surface material is plastic.

3(original). The dual surface bag of claim 1, wherein said dual surface material is a polymer.

4(original). The dual surface bag of claim 2, wherein said plastic material is a polyethylene material.

5(cancelled).

6(previously amended). The dual surface bag of claim 1, wherein said inside surface has a coefficient of friction range of approximately 0.175 to 0.250 and said outside surface has a coefficient of friction range of approximately 0.350 to 0.600.

7(previously amended). The dual surface bag of claim 1, wherein said bag comprises three layers.

8(previously amended). The dual surface bag of claim 7, wherein said three layers further comprise:

- a. a first layer having a coefficient of friction range of approximately 0.175 to 0.250;

- b. a second layer having a Dart Impact strength of approximately 95 grams per mil;  
and
- c. a third layer having a coefficient of friction range of approximately 0.350 to 0.600.

9-10(cancelled).

11(previously amended). An article of furniture covered with a plastic film bag comprising:

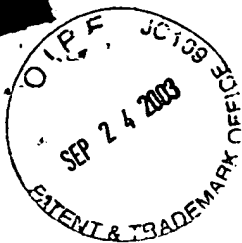
- a. an article of furniture; and
- b. a plastic film bag covering said article wherein said plastic film comprises:
  - i. a polymer inside surface having a coefficient of friction range of approximately 0.125 to 0.275;
  - ii. a polymer outside surface having a coefficient of friction range of approximately 0.300 to 0.600.

12-17(cancelled).

18(previously added). A bag formed of a dual surface material wherein said dual surface material comprises:

- a. an outer polymer film layer having a coefficient of friction range of approximately 0.300 to 0.600; and
- b. an inner polymer film layer having a coefficient of friction less than said outer layer.

19(previously added). The bag of claim 18, further including a middle polymer film layer which has a dart impact strength of between approximately 70 and 200 grams per mil.



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IN THE UNITED STATES OF AMERICA  
PATENT AND TRADEMARK OFFICE

In re the application of: Howard Lincecum

Atty Doc. #: 94478-00

Serial No.: 09/775,451

Examiner: Aughenbaugh, W.

Filed: 02/01/01

Group: 1772

For: Three-Layer Furniture Bag

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**Mail Stop APPEAL BRIEF-PATENTS**

Commissioner of Patents

P.O. Box 1450

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**CERTIFICATE OF MAILING**

Date of Deposit: September 16, 2003

I hereby certify that the following attached paper or fee:

- Appellant's Appeal Brief - in triplicate (19 pgs.);
- Appendix of Claims on Appeal (2 pgs.);
- Check for \$160.00 (appeal fee); and
- Stamped, return postcard;

is being deposited with the United States Postal Service on the date indicated above and is addressed to **Mail Stop APPEAL BRIEF-PATENTS**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Tina G. Matz